



FEB 20 2002

James F. Kamp
RADER FISHMAN & GRAUER
39533 Woodward Avenue, Suite 140
Bloomfield Hills, MI 48304

In re Application of
RYAN, Paul T. *et al*
U.S. Application No.: 09/913,425
PCT No.: PCT/GB00/00573
Int. Filing Date: 17 February 2000
Priority Date: 17 February 1999
Attorney Docket No.: 65446-0082
For: AN AUTOMATED SYSTEM FOR
EXCISING PROTEINS . . .

DECISION

UNDER

37 CFR 1.47(a)

This decision is in response to applicants' "Petition Pursuant to 37 CFR 1.47(a) Involving the Refusal of a Co-Inventor to Execute the Power of Attorney/Declaration" filed on 17 January 2002.

BACKGROUND

On 13 August 2001, applicants filed a transmittal letter for entry into the national stage in the United States under 35 U.S.C. 371 which was accompanied by, *inter alia*, a check to pay the basic national fee for a small entity.

On 17 October 2001, the United States Designated/Elected Office mailed a Notification of Missing Requirements under 35 U.S.C. 371 indicating that an oath/declaration in compliance with 37 CFR 1.497(a) and (b) and a surcharge fee of \$65.00 pursuant to 37 CFR 1.492(e) must be provided. Applicants were given two months to respond.

On 17 January 2002, applicants submitted the instant petition which was accompanied by, *inter alia*, a one-month extension request and extension fee of \$55.00; a declaration signed by two of the three co-inventors; the \$65.00 surcharge fee; a declaration by Mr. David Byatt ("Byatt Decl."); copies of two letters mailed to the nonsigning co-inventor; and authorization to charge any additional fees to counsel's Deposit Account No. 18-0013.

DISCUSSION

A petition under 37 CFR 1.47(a) must be accompanied by: (1) the required petition fee; (2) factual proof that the missing joint inventor refuses to execute the application; (3) a statement of the last known address of the missing joint inventor; (4)

and an oath or declaration executed by the signing joint inventor on his behalf and on behalf of the non-signing joint inventor. ~~Applicants failed to satisfy item (2).~~ 2

Concerning item (1), the \$130.00 petition fee has been charged to Deposit Account No. 18-0013 as authorized.

Concerning item (2), section 409.03(d) of the Eighth Edition of the MPEP explains what is required to prove a refusal by an inventor and states, in part:

A refusal by an inventor to sign an oath or declaration when the inventor has not been presented with the application papers does not itself suggest that the inventor is refusing to join the application unless it is clear that the inventor understands exactly what he or she is being asked to sign and refuses to accept the application papers. A copy of the application papers should be sent to the last known address of the nonsigning inventor, or, if the nonsigning inventor is represented by counsel, to the address of the nonsigning inventor's attorney. . . .

Where a refusal of the inventor to sign the application papers is alleged, the circumstances of the presentation of the application papers and of the refusal must be specified in a statement of facts by the person who presented the inventor with the application papers and/or to whom the refusal was made. . . . Proof that a bona fide attempt was made to present a copy of the application papers (specification, including claims, drawings, and oath or declaration) to the nonsigning inventor for signature, but the inventor refused to accept delivery of the papers or expressly stated that the application papers should not be sent, may be sufficient. When there is an express oral refusal, that fact along with the time and place of the refusal must be stated in the statement of facts. When there is an express written refusal, a copy of the document evidencing that refusal must be made part of the statement of facts. . . .

When it is concluded by the 37 CFR 1.47 applicant that a nonsigning inventor's conduct constitutes a refusal, all facts upon which that conclusion is based should be stated in the statement of facts in support of the petition or directly in the petition.

Here, applicants submitted a declaration by Mr. David Byatt, the Managing Director of Genomic Solutions Limited and a co-inventor who detailed the steps taken that led the 37 CFR 1.47(a) applicant to conclude that Mr. Auton refuses to sign the above-captioned application. Mr. Byatt states that he has "personal knowledge" of the facts and declares that "[o]n December 11, 2001, a second letter, including a copy of the above identified application and a Power of Attorney, was sent to Dr. Auton's last known home address." Byatt Decl. ¶ 1, 6. However, after contacting the

"ascertain that Dr. Auton has taken delivery of the December 11, 2001 letter and Power of Attorney" it was found that "Dr. Auton has taken delivery on December 17." Id. at ¶ 11. Finally, Mr. Byatt contacted the nonsigning inventor on 18 December 2001 and "Dr. Auton indicated that he would not sign the Power of Attorney." Id. at ¶ 12. Petitioners included copies of the 22 October 2001 and 11 December 2001 letters sent to the nonsigning inventor.

This is sufficient to satisfy item (2).

With regard to item (3), applicants satisfy this requirement by listing the last known address of the nonsigning co-inventor, Kevin Auton as:

42 Croftfield Road
Godmanchester, Huntingdon,
Cambridge, PE 29 2ED
United Kingdom

Regarding item (4), applicants included a Declaration signed by two of the three co-inventors. All the inventors' names, residences, post office addresses and citizenship are typed on the declaration. This declaration satisfies the requirements of section 409.03(a) of the Manual of Patent Examining Procedure (MPEP) and is in compliance with 37 CFR 1.497(a) and (b). Thus, item (4) has been satisfied.

Accordingly, all the requirements of 37 CFR 1.47(a) have been satisfied.

CONCLUSION

Applicants' petition under 37 CFR 1.47(a) is **GRANTED**.

Applicants have completed the requirements for acceptance under 35 U.S.C. § 371(c). The application has an international filing date of 17 February 2000 under 35 U.S.C. 363, and a 35 U.S.C. 371 date of **17 January 2002**.

As provided in 37 CFR 1.47(a), a notice of the filing of this application will be forwarded to the non-signing inventor at his last known address of record and will be published in the Official Gazette.



Leonard Smith
PCT Legal Examiner
PCT Legal Office



James Thomson
Attorney Advisor
PCT Legal Office

Tel.: (703) 308-6457



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For: AN AUTOMATED SYSTEM FOR
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Dear Mr. Auton:

You are named as an inventor in the above identified United States patent application, filed under the provisions of 37 CFR 1.47(a) and 35 U.S.C. § 116. Should a patent be granted, you will be designated as an inventor.

As a named inventor, you are entitled to inspect any paper in the file wrapper of the application, order copies of all or any part thereof (at a prepaid cost per 37 CFR 1.19) or to make your position of record in the application. Alternatively, you may arrange to do any of the preceding through a registered patent agent or attorney presenting written authorization from you. If you care to join in the application, counsel of record (see below) would presumably assist you. Joining in the application would entail the filing of an appropriate oath or declaration by you pursuant to 37 CFR 1.63.

Leonard Smith
PCT Legal Examiner
PCT Legal Office

James Thomson
Attorney Advisor
PCT Legal Office

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